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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/083,217 | 02/25/2002 | Mark T. Davis | PALM-3744 | 4736 |

7590

11/17/2005

WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

| EXAMINER |
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TORRES, MARCOS L

| ART UNIT | PAPER NUMBER |
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2687

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,217

Applicant(s)

DAVIS ET AL.

Examiner

Marcos L. Torres

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-12, 14-18 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-12, 14-18 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2005 has been entered.

Specification

2. The use of the trademark Bluetooth has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Response to Arguments

3. Applicant's arguments with respect to claims 1-3, 7-12, 14-18 and 23-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3, 9-12, 14, 17-20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suomela US 20030011467A1 in view of Yoshizawa US 20010036273A1.

As to claim 1, Suomela discloses a method of establishing a wireless connection to a device (see par. 0001), said method comprising: displaying a list of available devices within wireless range (see par. 0009); receiving a selection of a device that is included in said list; connecting wirelessly with said device (see par. 0010); and designating said device as a trusted device, wherein as a trusted device a passkey for

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said device, wherein said passkey is retrieved from memory and wherein manual input of said passkey is obviated for subsequent connections (see 0044) and indicating that said device in said list such that said device is distinguished from devices in said list that are not trusted devices (see par. 0051). Suomela does not specifically disclose exchanging passkeys with said device, said exchanging comprising sending a first passkey to said device and receiving a second passkey from the device. In an analogous art, Yoshizawa discloses exchanging passkeys with said device, said exchanging comprising sending a first passkey to said device and receiving a second passkey from the device, and using said second key for future connections (see par. 0008-0011), thereby making a faster and secure connection. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for the simple purpose of a secure user-friendly connection.

As to claim 2, Suomela discloses the method wherein connecting are performed substantially according to Bluetooth protocols (see 0028).

As to claim 4, Suomela discloses the method wherein said device is identifiable in said list as a device for which a passkey is stored in memory (see par. 0044).

As to claim 25, Suomela disclose the method comprising placing an icon adjacent the name of said device in said list indicate that said device is a trusted device (see par. 0050).

Regarding claims 9-12 and 14, they are the corresponding system claims of method claims 1-3. Therefore, claims 9-12 and 14 are rejected for the same reason shown above.

Regarding claims 17-18 and 26, they are the corresponding apparatus claims of method claims 1-3 and 25. Therefore, claims 17-18 and 26 are rejected for the same reason shown above.

8. Claims 7, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suomela in view of Yoshizawa as applied to claim 1 above, and further in view of Baptist US005465392A.

As to claim 7, Suomela disclose everything claimed as explained above except for the method comprising: deleting a device from said list. Baptist discloses the method comprising: deleting a device from a list (see col. 5, lines 21-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Suomela method for the simple reason of organization purposes.

Regarding claim 15 is the corresponding system claim of method claims 7. Therefore, claims 15 are rejected for the same reason shown above.

Regarding claims 23 is the corresponding apparatus claims of method claims 7. Therefore, claims 23 are rejected for the same reason shown above.

9. Claims 8, 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suomela in view of Yoshizawa as applied to claim 1 above, and further in view of Sormunen US006112078A.

As to claim 8, Suomela disclose everything claimed as explained above except for the method wherein said passkey is valid only for a specified period of time. Sormunen discloses the method wherein a passkey is valid only for a specified period of

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time (see col. 1, lines 50-55). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Soumela method for enhanced security.

Regarding claim 16 is the corresponding system claim of method claims 8.

Therefore, claims 16 are rejected for the same reason shown above.

Regarding claims 24 is the corresponding apparatus claims of method claims 8.

Therefore, claims 24 are rejected for the same reason shown above.

Conclusion

Any response to this Office Action should be mailed to:

U.S. Patent and Trademark Office
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P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

571-273-8300

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on 571-252-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres
Examiner
Art Unit 2687


mlt


11/14/05
LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER